

REMARKS

I. PRELIMINARY REMARKS

Claims 1, 3-5, 9, 11-13, 16, 23 and 25 have been amended. Claims 2, 6, 8, 10, 14, 15, 21 and 27-29 have been canceled. Claims 30 and 31 have been added. Claims 1, 3-5, 7, 9, 11-13, 16-20, 22-26, 30 and 31 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

II. OBJECTION TO THE SPECIFICATION

The specification has been objected to under 37 C.F.R. 1.75(d)(1). Applicant respectfully submits that the objection has been obviated by the correction of a minor typographical error in claim 25 and should be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103

A. The Rejections

Claims 1-5, 7-13, 15-19, 21 and 23-29 have been rejected under 35 U.S.C. § 102 as being anticipated by the Brownlee patent (U.S. Patent No. 6,282,303). Claim 20 has been rejected under 35 U.S.C. § 103 as being unpatentable over the Brownlee patent. Claims 6, 14 and 22 have been rejected under 35 U.S.C. § 103 as being unpatentable over combined teachings of the Brownlee patent and the Akizuki patent (U.S. Patent No. 6,360,004).

As claims 2, 6, 8, 10, 14, 15, 21 and 27-29 have been canceled, applicant respectfully submits that the rejections thereof have been rendered moot. The rejections of the remaining claim under 35 U.S.C. §§ 102 and 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. Discussion Concerning Claims 1, 3-5, 7, 9, 11-13, 16-20 and 22-26

Independent claims 1, 9 and 16 call for respective combinations of elements including, *inter alia*, “an at least partially transparent roller” and “a touch pad adjacent to the roller.” The cited references fail to teach or suggest such combinations.

For example, although the Brownlee patent discloses a fingerprint scanning/cursor control device including a transparent roller, the Brownlee patent does not teach or even remotely suggest placing the transparent roller adjacent to a touch pad.

The Akizuki patent, which suggests replacing separate fingerprint detecting and touch pad units with a single unit because users may confuse the separate units and attempt to use one for the purpose of the other (column 1, line 65 to column 3, line 3), fails to remedy the deficiencies in the Brownlee patent. Most notably, the Akizuki patent does not indicate that the fingerprint detecting unit and touch pad unit are adjacent to one another. Instead, the Akizuki patent states that “the fingerprint detecting unit 14 and the touch pad unit 24 are provided entirely independently of each other and are connected to the host computer 15.” [Column 1, lines 29-31.] The Akiluzi patent also specifically teaches away from placing a touch pad next to a fingerprint sensor and, to the contrary, suggests using a single device that functions as both a touch pad and a fingerprint sensor.

As the Brownlee and Akizuki patents fail to teach or suggest the respective combinations of elements recited in independent claim 1, 9 and 16, whether viewed alone or in combination, applicant respectfully submits that the rejection of claims 1, 3-5, 7, 9, 11-13, 16-20 and 22-26 under 35 U.S.C. §§ 102 and 103 should be withdrawn.

C. Additional Discussion Concerning Section 4 of the Office Action

Section 4 (page 8) of the Office Action states that “Brownlee further discloses that the user interface can be used in a constrained environment such as a laptop computer” and that “it would have been obvious to modify the user interface of Brownlee so that it was mounted on a computer housing.” These statements are respectfully traversed. The Brownlee patent does, in fact, refer to the constrained

physical environments of laptop computers in the “background” portion of the patent. [Column 1, lines 26-30.] However, the Brownlee patent does not appear indicate that the fingerprint scanning/cursor control device disclosed therein is applicable to laptop computers. The fingerprint scanning/cursor control device is instead shown and described in the context of a mouse (Figure 9), a trackball mouse (Figure 10) and a stand-alone keyboard (Figure 11).

IV. NEWLY PRESENTED CLAIMS 30 AND 31

Newly presented claims 30 and 31 respectively depend from independent claims 1 and 9 and, accordingly, are patentable for at least the same reasons as independent claims 1 and 9.

V. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant’s undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

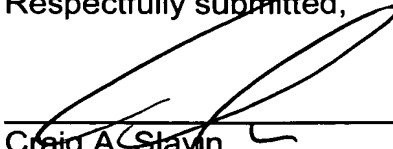
The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should

such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

8/23/04
Date

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Respectfully submitted,



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